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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,916	01/30/2004	Jean-Louis Gucret	118335	5691

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,916

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

Gregory Pickett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the amendment filed 22 September 2006.

Claims 1-35 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. In light of the applicant's amendment, the rejection of claim 21 under 35 U.S.C. 112, second paragraph, is withdrawn.

Claim Rejections - 35 USC § 102

4. Claims 1, 7-10, 13, 16-18, 24, 26, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Vicari (US 6,216,899; provided by applicant).

Claim 1: Vicari discloses a box (see for example Figure 1) with at least one base portion **10/20**, a lid **30**, a first element **20'**, and a second element **30'**. As disclosed by Vicari, elements **20'** and **30'** are of cooperating hook-and-loop material (i.e. VELCRO, see Figure 9), and although they are disclosed as latches, elements **20'** and **30'** are fully capable of functioning as hinges.

Claims 7-10: Vicari discloses four distinct first elements **20'**, including at opposite side faces of the base **10/20**, and four distinct second portions **30'**, all of which are complementary.

Claim 13: First element **20'** comprises fractions fixed on substantially planar surface **20**.

Claim 16: Vicari discloses four distinct element sets **20'** and **30'**, at least one of which may be considered a tab.

Claim 17: First element **20'** extends over side face **20**.

Claim 18: Second element **30'** extends over a side face of lid **30** (see Figure 9).

Claim 24: Vicari discloses relief portion **26** and complementary portion **31**.

Claim 26: Vicari discloses a housing (compartment formed by panels **10** and **20**) receiving at least one substance (automotive parts, Col. 1, lines 9-12).

Claim 32: Vicari discloses second base **11**.

Claim 33: Second element **30'** is movable relative to the box.

Claim Rejections - 35 USC § 103

5. Claims 1-3, 11, 12, 14, 15, 17-21, 24, 26-31, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian et al (US 7,047,983 B2; hereinafter Manougian) in view of Rago et al (US 6,626,432 B2; hereinafter Rago).

Claim 1: Manougian discloses a box **210** (see Figure 7) comprising a base portion **218**, a lid **216**, and a hinge **220**. Manougian discloses the claimed invention except that Manougian uses a pinned hinge instead of a hook-and-loop hinge.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because

these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Rago for the pinned hinge of Manougian. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claims 2, 17, 18, and 21: An interpretation of Manougian discloses a base portion **218** with a top face **258** and rear face (sidewall near hinge **220**), and a lid with a bottom face **264** and rear face (sidewall near hinge **220**). Rago teaches the hook-and-loop fastener wrapping around the top, side, and bottom of the base and lid (see Figure 6), and it would have been obvious to include the wrap-around feature in the combination of Manougian-Rago in order to enable the pivoting feature.

Claim 3: An interpretation of Manougian discloses a base portion **218** with a top face (portion holding third element **256'** of hook or loop material), and a lid **216** with a bottom face (portion holding fourth element **254'** of hook or loop material).

Claims 11 and 12: Manougian-Rago discloses the claimed invention except for the shape of the first element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first element of Manougian-Rago with the claimed wedge shape in order to conform to the increasing diameter of the base. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Claims 14, 15, 19, and 20: Base **218** of Manougian is a semi-circular cylinder; therefore the first element of the hook-and-loop hinge would comprise a fraction fixed on a surface that is not planar.

Claim 24: Manougian discloses relief portion **258** and cooperating portion **264**.

Claims 26 and 27: Manougian discloses housing **252** containing substance **214**; housing **252** is a dish.

Claim 28: Manougian discloses housing **242** with applicator **244** located on the lid portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing and applicator in the base portion in order to allow for a larger mirror. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 29: Manougian discloses housing **252** having a bottom comprising one of hooks and loops **256**.

Claims 30 and 31: Manougian discloses mirror **240** on a bottom face of lid **216**.

Claim 34: Manougian discloses box **210** as a cosmetic box (see for example the Abstract).

Claim 35: Manougian-Rago discloses the claimed structure, and Rago teaches the obvious use of the hook-and-loop hinge (see Col, 3, lines 50-55).

6. Claims 4-6 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian-Rago as applied to claims 1 and 3 above, and further in view of Flax (US 3,441,033) and Hunt (US 5,878,881; provided by applicant).

Manougian-Rago discloses the claimed invention except for the stacking base with hook-and-loop attachment.

Flax teaches a stacking base **12/14/16**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Manougian-Rago with a stacking base as taught by Flax in order to retain a larger number of articles. Flax also suggests cooperating relief's **32/38**.

Hunt teaches the use of hook-and-loop fasteners **66/68** for the connection of multiple bases **24** (see Figure 17) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Manougian-Rago with hook-and-loop fasteners on the bottom of base **218** as taught by Hunt in order to hold the plurality of bases together.

7. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian-Rago as applied to claim 1 above, and further in view of Beasley et al (US 5,115,916; hereinafter Beasley).

Manougian-Rago discloses the claimed invention except for the setback portion.

Beasley teaches a hook-and-loop fastener placed in a setback portion (see Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the hook-and-loop hinge of Manougian-Rago in a setback portion as taught by Beasley in order to accurately locate the hinge parts during assembly.

Response to Arguments

8. Applicant's arguments filed 22 September 2006 have been fully considered but they are not persuasive.

9. In response to the applicant's arguments that Vicari does not teach or suggest the claimed hinges, the absence of a disclosure relating to the function does not defeat the finding of anticipation since it is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schneller*, 44 USPQ 2d 1429 (Fed Cir. 1997); *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990); and *In re Benner*, 82 USPQ 49 (CCPA 1949). The straps of Vicari are flexible and fully capable of functioning as hinges in that the lid is capable of pivoting with respect to the container when a strap 20' is connected to a connecting portion 30'. Arguments concerning suggestion and modification are irrelevant since Vicari is cited as anticipatory.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. A *prima facie* case of obviousness is established by presenting evidence indicating that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having those teachings before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

12. In response to applicant's argument that Rago is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rago is pertinent to hinge structures.

13. In response to the applicant's argument that Manougian teaches away from the claimed invention, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, "[t]he prior art's mere

disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

14. Applicant’s argument that the claimed hinge structure would render Manougian unsuitable for its intended purpose is not found persuasive since the cited reinforcement is considered optional by Manougian, and not a required feature. Moreover the principal of operation (i.e. the hinge feature) is not changed by substituting one hinge structure for another.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Greg Pickett
Examiner
30 November 2006


Mickey Yu
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Group 3700